

## **REMARKS**

### **Amendments**

Claims 1, 3, 4, 10 and 12 have been amended to specifically include the definition of Ar<sup>3</sup> and Ar<sup>4</sup>. Support for these amendments can be found, at least, in originally filed claims 1, 3, 4, 10 and 12, respectively. No new matter has been added by this amendment.

### **Restriction Requirement**

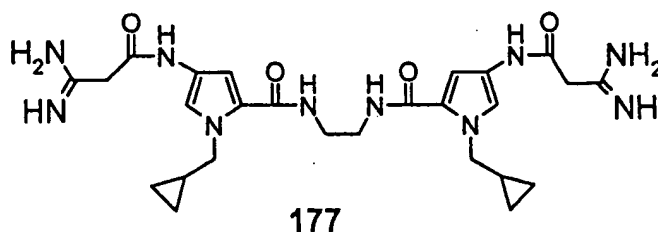
In the Office Action, the claimed invention was restricted into the following groups (in summary)

- Group I. Claims 1, 3-4, 6-14, and 20-21, in part, drawn to compounds/compositions of formula (1), wherein R<sup>3</sup> is not and does not contain a heteroaryl or heterocyclic group, L is a non-heteroatom containing group, and m and n are 0 or 1.
- Group II. Claims 1, 3-4, 6-14, and 20-21, in part, drawn to compounds/compositions of formula (1), wherein R<sup>3</sup> is not and does not contain a heteroaryl or heterocyclic group, L is 1-(5-(trifluoro-pyrimidin-2-ylhydrazidocarbonyl)-1,5-pentylene, and m and n are 0 or 1.
- Group III. Claims 1, 3-4, 6-14, and 20-21, in part, drawn to compounds/compositions of formula (1), wherein R<sup>3</sup> is not and does not contain a heteroaryl or heterocyclic group, L is 1-[2-(6-nitrobenzimidazol-ylethylaminocarbonyl)-1,5-pentylene, and m and n are 0 or 1.
- Group IV. Claims 1, 3-4, 6-14, and 20-21, in part, drawn to compounds/compositions of formula (1), wherein is not and does not contain a heteroaryl or heterocyclic group, L is 1-(2-(2-trifluoromethylquinolin-4-yl)thio-ethylaminocarbonyl)-1,5-pentylene, and m and n are 0 or 1.

Group V. Claims 1, 3-4, 6-14, and 20-21, in part, drawn to compounds/compositions of formula (1), receiving compounds not encompassed in Groups I-IV.

In response to this restriction requirement, Applicants elect, with traverse, the invention of Group I for examination on the merits. In a separate requirement the Office Action requires Applicants to elect a species.

In compliance with the further election of species requirement, Applicants hereby provisionally elect, with traverse, the same structure elected in the restriction requirement sent by the Patent Office on 11/29/2001:



This compound is found, for example, in FIG. 10 for the specification as compound 177. Applicants submit that claims 1, 4, 6, 8, 9, 14, 20 and 21 read on this elected species.

As to Applicants' traverse of the restriction requirement, the Examiner has fragmented Applicants' compound genus into 5 sub-genuses of the Examiner's choosing, with the indication that upon election of Group V further restrictions will be required. More specifically, In Group I the Examiner has dissected each of the Markush groups in Claim 1 defining  $R^1$  and  $R^2$ ;  $R^3$ ; and L. The first new Markush grouping selected by the Examiner contains the compounds of Formula I wherein either  $R^1$  and  $R^2$ ;  $R^3$ ; or L are 1) functional groups that are not heteroaryl, substituted heteroaryl, or heterocycle and 2) are functional groups not substituted with either heteroaryl, substituted heteroaryl, or heterocycle groups. The second new Markush grouping selected by the Examiner contains the compounds of Formula I wherein  $R^1$  and  $R^2$ ;  $R^3$ ; or L are

everything not excluded in the first group. Finally the Examiner designates R<sup>3</sup> of –COR<sup>3</sup> to be pyrrolidine – which is a five membered ring containing a nitrogen atom, or a heterocycle.

In Groups II-IV the Examiner has dissected each of the Markush groups in Claim 1 defining R<sup>1</sup> and R<sup>2</sup>; and R<sup>3</sup>. The first new Markush grouping selected by the Examiner contains the compounds of Formula I wherein either R<sup>1</sup> and R<sup>2</sup>; or R<sup>3</sup> are 1) functional groups that are not heteroaryl, substituted heteroaryl, or heterocycle and 2) are functional groups not substituted with either heteroaryl, substituted heteroaryl, or heterocycle groups. The second new Markush grouping selected by the Examiner contains the compounds of Formula I wherein R<sup>1</sup> and R<sup>2</sup>; or R<sup>3</sup> are everything not excluded in the first group. In each of these groups is a specified heteroarylene group. Finally the Examiner designates R<sup>3</sup> of –COR<sup>3</sup> to be pyrrolidine – which is a five membered ring containing a nitrogen atom or a heterocycle.

Group V is directed to everything not excluded by the Examiner in the previous groups and is subject to further restriction.

Such fragmentation of a Markush compound genus through the use of a restriction requirement is clearly improper because it is inconsistent with the applicable case law and contrary to the express directions given by the Patent Office's stated guidelines for restriction of Markush groups as set forth in MPEP §803.02.

Specifically, in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978), the court articulated the general proposition that:

[A]n applicant has a right to have *each* claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable

that a number of the fragments would not be described in the specification. *Id.* at 331. (Emphasis in original).

Restated in a more recent opinion from the Federal Circuit in *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed Cir. 1990) at page 1409:

Under *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334, it is *never* proper for an examiner to reject a Markush claim under 35 U.S.C. § 121. *Id.* Section 121 simply does not authorize such a rejection.\*\*\*[W]ith regard to section 121, the rejection of a Markush claim is different from a restriction requirement between different claims. (Emphasis in original, citations omitted)

In view of the case law, the Patent Office has set forth the following general policy regarding restriction of Markush-type claims in MPEP §803.02:

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334, it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984).

In the present case, the Patent Office has refused to examine the claims in the form Applicants consider to best define their invention and has instead required Applicants to elect only a dissected portion of these claims for prosecution. The Examiner's use of a "restriction requirement" to force Applicants to limit the genus to one of the "inventions" within the scope of the Markush claim, when the compounds share a common utility and have a common nucleus, is clearly improper in view of the applicable case law and the stated policy of the Patent Office. In determining the propriety of a Markush grouping the compounds must be considered as a whole and not broken down into elements or other components. While the Patent Office is allowed to reject a Markush claim based on the judicially created doctrine of improper Markush group based on lack of unity of invention, such a rejection would not be proper in the present case because the claimed compounds all share a substantial structural feature which is disclosed as being essential

to at least one disclosed utility (See , *In re Harnish, supra* at 305; and *Ex parte Hozumi, supra* at 1060

In view of the above, withdrawal of the restriction requirement and recombining groups I to V is requested. In the event that the restriction is maintained, Applicants reserve the right to appeal this decision as a lack of unity of invention rejection (See , *In re Harnish, supra*).

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

Date

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By

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